

TMH:SLR:dm 12/22/05 465301.doc SMW/CP5914676  
PATENTAttorney Reference Number 6947-67468-01  
Application Number 09/817,661**Remarks**

Claims 1-30 were pending. Claims 15-20 and 24-30 were withdrawn due to the restriction requirement. No claims are added. Therefore, claims 1-14 and 21-23 are now pending.

Claim 1 was amended to clarify the claim. Support can be found throughout the specification, for example: page 6, lines 10-14; page 8, lines 11-14; page 15, lines 21-24; page 16, lines 7-8; page 17, lines 8-11; and page 35, lines 4-14.

No new matter is added by this amendment.

Applicants thank the Examiner for withdrawing the previous objection to the specification.

**35 U.S.C. § 103(a)**

Claims 1, 8-14 and 21-23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Pluckthun *et al.* (WO 98/48008), Dubois *et al.* (WO 98/00547) and Landt *et al.* (Gene 96:125-8, 1990). Applicants disagree and request reconsideration.

Claim 1 has been amended to clarify the term "of" in the phrase "...encapsidating mRNA of complexes of mRNA, ribosome, and displayed specific binding member" and to clarify when the viral coat proteins are provided to the mRNA for encapsidation.

There is no motivation for one skilled in the art to combine the teachings of Pluckthun and Dubois, as the documents serve different purposes. For example, Pluckthun teaches a ribosome display method. The method of the present invention is directed to an improved method of ribosome display. In contrast, the teachings of Dubois are not directed to ribosome display, but are instead directed to nuclease resistant nucleic acids that can be used as standards in diagnostic assays. Therefore, those skilled in the art would not logically combine the Pluckthun and Dubois references.

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As stated on page 5 of the Office action, Pluckthun does not disclose the use of encapsidation to protect the mRNA in a viral coat protein. Although it is asserted on page 6 of the Office action that Dubois teaches use of in vitro encapsidation using viral coat proteins to protect labile mRNA, the mRNA is encapsidated post transcription. For example, whilst Dubois on page 56 indicates that the Armored RNA<sup>TM</sup> could be added to a rabbit reticulocyte in vitro translation system, no experimental details are given. In fact, if one followed this teaching it would result in the addition of mRNA which has been encapsidated prior to translation and not co-translationally or following translation, as is claimed in the present application. Therefore, even if one were to combine the Pluckthun and Dubois documents and used the teachings therein, one could not arrive at the claimed invention. In fact, this combination would produce an entirely different result.

Neither Pluckthun *et al.* (WO 98/48008) nor Landt *et al.* (Gene 96:125-8, 1990) teach or suggest use of encapsidation to protect the mRNA in a viral coat protein and that the mRNA can be encapsidated co-translationally or following translation. Therefore, claims 9 and 21 are not obvious in view of these documents.

In summary, the teachings of Dubois are concerned with providing ribonuclease resistant RNA standards for use in diagnostic assays and assays for specific mRNA species. As such, the mRNA is encapsidated post transcription, not co-translationally or following translation. In contrast, the claims of the present application specify that the mRNA is encapsidated co-translationally or following translation. Therefore, the display of protein translated from mRNA, the encapsidation of which occurs during or post translation, is non-obvious in view of the prior art.

In view of the amendment to claim 1, and the arguments presented above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of the claims be withdrawn, and that since a generic claim is allowable, to re-examine the non-elected species (such as claims 2-7).

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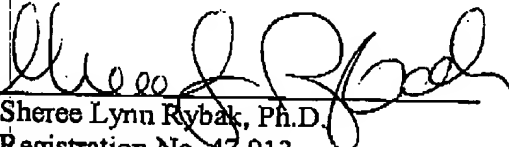
If any minor issues remain before a Notice of Allowance is issued, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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